

## REMARKS

In the Office Action mailed February 6, 1998, the Examiner objects to the specification because the previous revision for page 28, as submitted by the Amendment mailed December 22, 1997, was incorrectly entered on line 5 rather than on line 7 as requested. Although the Examiner acknowledges that pending claims 1-20 are allowable over the prior art, these pending claims are provisionally rejected under the judicially-created doctrine of double patenting over claims 1-93 of copending application 08/700,225 and claim 22 of copending application 08/700,217.

On April 24, 1998, a formal interview was held at the U.S. Patent and Trademark Office with Examiner Batson, Supervisory Examiner Carone, and the undersigned to discuss the merits of the double patenting rejection. As required by 37 C.F.R. § 1.133 and as set forth in Section 713.04 of the Manual of Patent Examining Procedure, a complete and proper record of the substance of the formal interview is set forth on Form PTO-413 as completed by the Examiner. As requested by the Examiner, however, Applicants set forth below the arguments and remarks that were discussed during the formal interview regarding the impropriety of the double patenting rejection.

Applicants appreciate the time provided by the Examiner in considering this application and in identifying the allowable subject matter. Applicants particularly appreciate the time extended to the undersigned during the interview to discuss the merits of this application.



### **The Objection To The Specification**

By this Amendment, Applicants revise page 28 of the specification to correct the improper entry of the amendment previously submitted on December 22, 1997. That is, line 7 was to be revised so as to indicate more clearly that the spring structure 350 is best shown in Fig. 26. Apparently, this amendment was inadvertently entered on line 5 by the U.S. Patent and Trademark Office. The amendments submitted herewith therefore replace the original language of line 5 and repeat the revision previously presented on December 22, 1997. In making these revisions, care has been taken to ensure that no new matter has been added and that the claims remain supported by the specification. Applicants therefore request that the objection to the specification be withdrawn.

### **The Double Patenting Rejection**

With regard to the rejection of the claims, and as discussed with the Examiner in detail, Applicants respectfully submit that allowance of pending claims 1-20 of this application is not precluded under the judicially-created doctrine of doubling patenting over the identified claims of copending applications, Serial Nos. 08/700,217 and 08/700,225 (collectively hereinafter, the "Copending Applications"), nor any claim of the other copending applications filed on even date by the Assignee of this application. Applicants therefore respectfully traverse the doubling patenting rejection set forth by the Examiner for the reasons below.

#### **A. The Claimed Subject Matter Of Each Application Is Distinct**

The claimed subject matter of this application and those of the Copending Applications are each distinct from the other. For example, and as recognized by the Examiner, the claims of this application are directed to a seed metering mechanism including the

combination of a housing, a seed disc and a novel configuration of openings. By contrast, claim 22 of copending application Serial No. 08/700,217 recites a seed metering mechanism including a housing, a seed disc and a novel agitator assembly; the claims of copending application Serial No. 08/700,225 recite a seed metering mechanism including a housing, a seed disc and a novel seed singulator assembly. Although related to a seed metering mechanism, the combination claims of each application specifically include a novel subcombination that is recognized by the Examiner to be patentably distinct over the prior art. Furthermore, and as acknowledged by the Examiner, each novel subcombination, as well as the claimed combination including such novel subcombination, has (i) attained recognition in the art under a separate classification and (ii) required a different field of search. The combination claims of each application therefore are distinct from those of the other applications.

The Examiner states that there is no apparent reason why the Applicants did not present the claims of this application and those of the Copending Applications in a single application. Applicants respectfully submit that the claimed subject matter of this application and those of the Copending Applications would have been subject to a restriction requirement under 35 U.S.C. §121 if originally filed together as a single application. As such, this application and the Copending Applications were filed separately, but on the same day, to avoid unnecessary delay in addressing such a restriction requirement. A double patenting rejection of these distinct combination claims therefore would be inappropriate.

**B. The Non-Obviousness Type Doubling Patenting Rejection Is Improper**

In provisionally rejecting claims 1-20, the Examiner notes that the claimed subject matter of this application is fully disclosed in the Copending Applications and, therefore,

believes that any patent granted on the Copending Applications would cover the subject matter of this application. Particularly, the Examiner notes that claims 1-20 of this application are directed to a seed metering mechanism including, among other things, a housing, a seed disc, and an opening. Because the transitional term “comprising” is used, the Examiner indicates that these claims also may encompass a seed metering mechanism further having an agitator or a seed singulator in addition to an opening. The Examiner therefore believes that patent protection for the claimed subject matter of the Copending Applications would extend the protection afforded by the claims of the present application.

As acknowledged by the Examiner during the formal interview with the undersigned, the rejected claims of this patent application are not the same as or identical to those of the Copending Applications. The double patenting rejection therefore is not made under 35 U.S.C. §101. Furthermore, it is recognized by the Examiner that the claimed subject matter of this application is not merely an obvious variation of that claimed in the Copending Applications. The double patenting rejection therefore is not made under the judicially-created doctrine of “obviousness-type” double patenting. Rather, the Examiner relies upon In Re Schneller, 397 F.2d 350 (C.C.P.A. 1968) and related internal memoranda of the U.S. Patent and Trademark Office, which are attached as Exhibits A and B hereto, to establish the basis for this “non-obviousness type” doubling patent rejection.

The court of Schneller states that “the fundamental reason for the rule [against double patenting] is to prevent *unjustified timewise extension* of the right to exclude granted by a patent no matter how the extension is brought about.” (Emphasis added). Schneller, 397 F.2d

at 354. Applicants respectfully submit that no such timewise extension would result from allowance of the claims of this application.

The subject matter of Schneller involved a single-piece wire clip including the combination of known elements “ABC” and novel features “X” and “Y.” A parent application was filed in 1955, and issued in 1960 with claims directed to a wire clip including features “ABCX.” In 1962, a subsequent divisional application was filed directed to a single-piece wire clip including the combination of “ABCY and “ABCXY.” Although no “obviousness-type” or “same-invention-type” double patenting was found, the court of Schneller held that, if the applicant prevailed, “the end result would be the grant of another patent effectively extending the time during which he may exclude others from practicing an invention which is disclosed and claimed in his issued patent.” Id. This holding was based upon, among other things, the fact that the divisional application was not filed until nearly seven years after the filing date of the parent application. See also, Exhibit A, Example V, emphasizing “earlier filed patent” and “later filed copending patent application.”

It is further noted that the court of Schneller indicated that a valid excuse or a mitigating circumstance may exist so as to make it reasonable or equitable to make an exception. Id., at 355. Indeed, the court of Schneller expressly distinguished the case of In re Sutherland, 347 F.2d 1009 (C.C.P.A. 1965), wherein no double patenting was found between two commonly-assigned applications that were prepared by the same attorneys so as to contain “much common subject matter in their specifications” and identical drawings, and that were filed on the same day. Sutherland, 347 F.2d at 1009.

Sutherland generally involved two applications that disclosed a known process including the steps “AB” and two improvements “X” and “Y,” wherein the best mode of practicing each improvement was in conjunction with the other. Id., at 1012. The claims of each application used the “comprising” transitional language -- one application being directed to the process “AB” including the improvement “X” and the other application being directed to the process “AB” including the improvement “Y.” Id., at 1010-1011. In reviewing these facts, the court of Sutherland aptly summarized that “[t]he situation...is that applications for two distinct improvements on an old agglomeration process, invented by different inventors, assigned to the same assignee, and filed on the same day were before the same examiner.” Id., at 1011. Recognizing that the disclosure of one application cannot be used as a reference against the other, the court concluded that “[t]hough the two inventions relate to the same basic process and even though they are capable of conjoint use, they are independent and distinct inventions. Either can be used without the other.” Id., at 1016. No double patenting was found.

The facts of the Sutherland are particularly on point with those of the present application and Copending Applications. As with Sutherland, each application at issue was prepared by the same attorneys for the same corporation, although with differing inventive entities, so as to share certain descriptions and drawings. Furthermore, each application was filed on the same day and is specifically directed to a distinct invention that can be used independent of the claimed inventions of the other applications as previously established. Indeed, by filing each of the separate applications on the same day, no unjustified timewise extension of the right to exclude others from practicing the respective claimed invention is possible under the new patent term established in accordance with the General Agreement On

Tariffs And Trade (GATT). Applicants therefore respectfully submit that a non-obviousness type doubling patenting rejections is improper, at least for the reasons expressly recognized by the courts of both Schneller and Sutherland.

**C. No Terminal Disclaimer Is Required**

In rejecting claims 1-20, the Examiner states that “[t]he non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially-created doctrine grounded in public policy...so as to prevent the unjustified or improper timewise extension of the ‘right to exclude’ granted by a patent.” As established above, no unjustified “timewise” extension of the right to exclude others from practicing the respective claimed invention will occur by allowance of the claims of this application, at least because all the applications at issue were filed on the same day.

The Examiner also has suggested, however, that the policy behind double patenting further prohibits the extension of the “right to exclude” that would occur if the applications at issue were not commonly owned. The Examiner therefore indicates that a terminal disclaimer is required to ensure that these applications, or resulting patents thereof, remain commonly owned. During the interview on April 24, 1998, and in support of this requirement for a terminal disclaimer, the Examiner referenced M.P.E.P. § 804.02, which states that “a common issue date alone does not avoid the potential problem of dual ownership of patents to *patentably indistinct inventions*.” (Emphasis added). Although Applicants recognize the principle referenced by the Examiner, Applicants respectfully submit that this principle is not relevant under the present circumstances. That is, and as established above, the claimed inventions of the various applications are indeed patentably distinct from each; as such, no

problem related to dual ownership of patents to patentably indistinct inventions can arise. Furthermore, no unjustified “subject matter” extension of the right to exclude others from practicing the respective claimed invention will occur by allowance of the claims of this application, at least because each application is directed to a distinct invention that is classified separately from and can be practiced independently of the other inventions. As such, no terminal disclaimer is required.

Based upon the above, Applicants respectfully request that the provisional rejection of claims 1-20 under the judicially-created doctrine of double patenting be withdrawn.

### **Conclusion**

In conclusion, Applicants respectfully request withdrawal of the previous objections and rejections set forth by the Examiner, and the timely allowance of pending claims 1-20. Favorable action is respectfully requested.

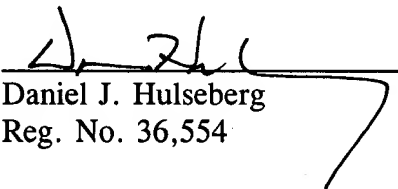
If any additional information is required, the Examiner is invited to contact the attorney of record, Daniel J. Hulseberg, at (312) 701-8606.



The Commissioner is hereby authorized to charge any additional fees (or credit any overpayment) associated with this communication to our Deposit Account No. 13-0019.

If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such extension is requested and such fee should also be charged to our Deposit Account.

Respectfully submitted,



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